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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,682	06/16/2005	Alexander Macasaet	30882/DP027	8592

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EXAMINER

PERREAULT, ANDREW D

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

06/03/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/539,682

Applicant(s)

MACASAET ET AL.

Examiner

ANDREW PERREAULT

Art Unit

3728

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-7, 10-12, 15-17, 19, 20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 10-12, 15-17, 19, 20, and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-3, 5-7, 10-12, 15-17, 19, 20, and 22 stand.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 5, 6 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5 and 6 recite the limitation "the at least one perforate line" in line 2. There is insufficient antecedent basis for this limitation in the claims.

Claim 19 provides for the use of a container, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 19 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 5-7, 15, 16, 19, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Timbrook et al. (6,685,084) in view of Buchman (5,525,030).

Re claim 1, Timbrook discloses a container (10 as a sleeve without top or bottom flaps as disclosed in col. 1: 20-25) comprising at least three sidewalls (12) with corners therebetween (corners between 12), the sidewalls defining an internal space (space inside of 10 in fig 1) for storage of at least one item and a storage area (area defined by space), the shape of the storage area depending on the number of the sidewalls; the sidewalls being foldable about the corners for ease of storage (the sidewalls are able to perform the intended use of folding along lines formed by 14); the sidewalls having an open base and an open top (10 as a sleeve without top or bottom flaps as disclosed in col. 1: 20-25); and a pallet (pallet that the container fits on as described I col. 1:20-25) with a planar top onto which the sidewalls are placed (container is placed on the pallet); wherein the sidewalls and the pallet combine to form an open top box and the top of the pallet forms a base for the sidewalls (10 is a sleeve without top or bottom flaps as disclosed in col. 1: 20-25); the storage area being disposed immediately adjacent the planar top of the pallet, the open base of the sidewalls allowing at least one item to be placed directly on the pallet and within the storage area (since the container is formed

as a sleeve and placed on a pallet, the device is able to perform the intended use of allowing an item to be placed directly on the pallet); but does not disclose a circumferential gap as part of the planar top of the pallet formed between an outer edge of the at least three sidewalls and a peripheral edge of the top of the pallet. Buchman discloses a similar device (figs 1-7) comprising a circumferential gap as part of a planar top of a pallet formed between an outer edge of at least three sidewalls and a peripheral edge of the top of the pallet (as shown in figs 5, 6 a box rests on top of a pallet with a gap between the edge of the box sidewall and the edge of the pallet). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Timbrook in view of Buchman, including a circumferential gap as part of the planar top of the pallet formed between an outer edge of the at least three sidewalls and a peripheral edge of the top of the pallet, to ensure that the container does not fall from the pallet by providing a gap (Buchman figs 5, 6).

Re claim 2, Timbrook discloses that the sidewalls are made of a material selected from the group consisting of: cardboard, treated cardboard and a plastics material (abstract, col. 3: 20-25)

Re claim 5, Timbrook discloses that the sidewalls are foldable (sidewalls are able to perform the intended use of folding along lines at 14) along at least one perforated line to vary the height of the sidewalls.

Re claim 6, Timbrook discloses that the sidewalls are shearable (sidewalls are able to perform the intended use of shearing along lines at 14) along the at least one perforated line to vary the height of the sidewalls.

Re claim 7, Timbrook in view of Buchman discloses the claimed invention above with the exception of the following claimed limitation that is further taught by Buchman: a top being of a length and width slightly greater than the corresponding dimensions of sidewalls (Buchman figs 5, 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Timbrook in view of Buchman, and further in view of Buchman, for the same reasons as provided above in claim 1.

Re claims 15 and 16, Timbrook discloses that the top of the pallet forms a solid base for the sidewalls (the container is supported by the pallet and therefore the pallet forms a solid base; col. 1: 20-25)

Re claim 19, Timbrook discloses a use of a container as a single standardized container that may be customized to meet the needs of different load and height requirements of objects to be stored and transported (customization is disclosed in col. 2: 1-12)

Re claim 20, Timbrook discloses that the storage area has a triangular, rectangular, pentagonal or octagonal shape (octagonal shape is disclosed in fig 1).

Re claim 22, Timbrook discloses that each sidewall of the container has at least one perforated line (line at 14) to enable the height of the sidewalls to be varied (col. 3: 37-44), wherein at least one perforated line is parallel to an edge of the base for folding (line parallel in fig 1).

3. Claims 3, 11, and 12 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the Timbrook in view of Buchman as applied to claims 1 and 2

above, and further in view of applicant's admitted prior art (with reference to claims 3, 11, and 12 in office action 10/24/08, applicant has not challenged the examiner's official notice; therefore, the official notice is now considered admitted prior art. See MPEP 2144.03) or Barnes et al. (3,968,895).

Re claims 3, 11, and 12, Timbrook in view of Buchman do not disclose wherein the material is weather-resistant and the pallet material type. However, applicant's admitted prior art discloses wherein the material is weather-resistant and the pallet material type. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to Timbrook in view of Buchman and further in view of applicant's admitted prior art, including wherein the material is weather-resistant, as suggested and taught by applicant's admitted prior art, for the purpose of protecting the device from damage. Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the material because it has been held that selection of a known material on the basis of its suitability for the intended use was an obvious extension of the prior teaching. *In re Leshin*, 125 USPQ 416. Additionally, Barnes et al. teaches a similar container 1 (fig. 1) including four sidewalls 11a-11c, 15, a cover 37, and a pallet 3 (fig. 1) wherein the sidewalls 11a-11c, 15 are made of a material consisting of plastics (col. 5, lines 30-41), wherein the material is weather-resistant (col. 5, lines 30-41); and the pallet 3 is formed of a material of plastics (col. 5, lines 30-41), wherein the material is weather resistant (col. 5, lines 30-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Timbrook in view of Buchman, and further in view of Barnes, such that

the sidewalls and pallets are made of a plastic weather-resistant material, as suggested and taught by Barnes et al., in order for the container to be reused by being capable of withstanding damage from rough transporting conditions such as inclement weather and chemicals (Barnes col. 5, lines 30-41).

4. Claim 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Timbrook in view of Buchman as applied to claim 1 above, and further in view of New (2,145,430).

Re claims 17 and 10, Timbrook in view of Buchman discloses the claimed invention above with exception of the following claimed limitations that are taught by New: a cover (16) for an open top and an internal space (top of 10 and internal space of 10); wherein the cover is shaped to conform with the internal space defined by the sidewalls (as in figs 1, 2) and comprises a cover top (top of 16), and cover sides (sides of 16), the cover being adapted to be readily removable over the open top and locatable on an outer surface of at least three sidewalls in the manner of a snug fit (the cover is able to perform the intended use of removing and locating). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Timbrook in view of Buchman, and further in view of New to provide a covering device to protect and gain access to the intended contents of the device (New col. 1: 33-50).

Response to Arguments

Applicant's arguments with respect to claims have been considered but in view of the amendment the search has been updated and a new rejection has been applied.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **ANDREW PERREAULT** whose telephone number is (571)270-5427. The examiner can normally be reached on Monday - Friday, 8:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on (571)272-4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. P./
Examiner, Art Unit 3728

/Ehud Gartenberg/

Supervisory Patent Examiner, Art Unit 3728